REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated March 11, 2008. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-33 are pending in the Application. Claim 1 is the sole independent claim.

Applicants respectfully request the Examiner to acknowledge the claim for priority and receipt of certified copies of all the priority document(s).

In the Office Action, claims 1-33 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Publication No. 2006/0075418 to Kurt ("Kurt"). Claims 1-33 are provisionally rejected under non-statutory obviousness-type double patenting as allegedly unpatentable over claims 1-44 of the U.S. Patent No. 10/537,879 to Kurt, which is the patent application of Kurt ("the Kurt Application").

Regarding the rejection under 35 U.S.C. §102(e) in view of Kurt, it is respectfully submitted that Kurt is not prior art to the present patent application. Under 35 U.S.C. §102(e), a reference is only prior art if (emphasis provided) "the invention

was described in – (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent ..." While it is true that under 35 U.S.C. §102(e), "an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States", however, it is only the filing date of the international application that is considered.

The present patent application was PCT filed on November 17, 2003 as PCT/IB2003/05253, designates the U.S., is published in English and claims the benefit of a European Patent Application No. EP 02080615.4, filed on December 18, 2002. Accordingly, the effective filing date of the present patent application is December 18, 2002. Kurt was PCT filed on November 12, 2003 as PCT/IB2003/05101, however in consideration of Kurt as prior art against the present patent application, Kurt does not get a benefit from any foreign filed patent applications and accordingly, has an effective filing date of November 12, 2003.

As the effective filing date of the present patent application of December 18, 2002, precedes the November 12, 2003, filing date

of Kurt, Kurt is not prior art under 35 U.S.C. §102(e) with regard to the present application.

Regarding the provisional rejection under the judicially created doctrine of obviousness-type double patenting regarding claims 1-33 of the present patent application over claims 1-44 of copending U.S. Patent No. 10/537,879, namely the Kurt Application, Applicants respectfully traverse the rejection. The Office Action asserts that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because they disclose the same recording medium comprising multiple recording areas which may be formed of nanotubes or nanowires of the same materials."

Claim 1 of the Kurt Application is directed to an optical information record medium wherein the information layer is constituted by a transparent layer wherein nanoelement tubes having a symmetry axis are embedded. In contrast, claim 1 of the present patent application is directed to an optical information recording medium having nano-elements that are capable of emitting luminescent light. While the Office Action acknowledges that "[t]he claims are not identical" it however comes

to the conclusion that "when looking to the specification to further define the claims, all limitations are found."

However, Applicants respectfully submit that an examination of the specification of the Kurt Application to find material cited in the present patent application claims is improper since the test for double patenting requires a comparison of the claims of the Kurt Application and the claims of the present patent application. While under MPEP 804 (II)(B)(1), one is not precluded from all use of the patent disclosure, (emphasis added) "[w]hen considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." Furthermore, an obviousness-type double patenting rejection should make clear the "reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent." Id. The proposition that elements of the specification may be read into a claim to in effect, modify the claim, does not meet this requirement. One may not utilize the specification to modify an unambiguous claim recitation to arrive at the present claims when considering an obvious-type double patenting rejection.

Accordingly, withdrawal of the double-patenting rejection to claims 1-33 is respectfully requested. Based on the foregoing, the Applicants respectfully submit that claims 1-33 are allowable and an indication to that effect is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By _____

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